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10/806,663	03/18/2004	Yaron Mayer		1166

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EXAMINER

SHAH, AMEE A

ART UNIT PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/806,663

Applicant(s)

MAYER, YARON

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-42 are pending in this action.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p) because they contain improper shading that does not aid in the understanding of the invention and will not reproduce properly.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. *See* MPEP § 608.01.

The use of trademarks such as COMSCORE, DEALTIME.COM, BIZRATE, PRICEGRABBER, NEXTAG, CNET, ADDALL, IBM, AMAZON.COM, ACTIVEX and FEDEX has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-42 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and

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positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 1 and 22 recite, in part, the limitation “comprising **at least one of** at least one server capable ... and a program running on the user’s computer...”

[emphasis added]. The term “at least one of” is prevalent throughout all the claims and is interpreted in the alternative, i.e. an “or.” The claims do not clearly set forth the metes and bounds of the patent protection desired. *See* MPEP § 2173.05(c). For example, in claims 1, is the invention a system comprising a server capable of searching multiple vendor sites and a server capable of executing the computations needed for finding an acceptable offer or is the invention a server and a program or is the invention a program and a program? For purposes of this action only, the Examiner will interpret the claims in the manner indicated below.

Claims 2, 3, 17, 18, 23, 24, 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 22 recite the limitation “at least one of ... other heuristic estimates,” claims 3, 17, 23 and 38 recite the limitation “at least one of ... other heuristics,” and claims 18 and 38 recite the limitation “other known methods.” The claims are recited in the alternative (at least one of) and the limitations of “other heuristic estimates,” “other heuristics,” and “other known methods” renders the claims indefinite because the claims include elements not actually disclosed (i.e. those encompassed by other heuristic

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estimates or known methods), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claims 4-6, 13, 25-27 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4 and 24 list alternative features for the system/method of claims 1 and 21. Prior art need only disclose one of these alternative features. The alternate features render claims 5, 6, 13, 26, 27 and 34 indefinite sine it is unclear to one of ordinary skill in the art the scope of the claims if the features disclosed in claims 5, 6, 13, 26, 27 and 34, i.e. the features of criteria for deciding if to order some of the items directly or not and of criteria for deciding when to offer the user aggregating services, are not the chosen features. Applicant's specification does not preclude the features not being present. Therefore, the limitations of claims 5, 6, 13, 26, 27 and 34 will not be considered in the analysis of the claims.

Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8-10 recite steps suitable for a method, i.e. the user takes certain actions, while the claims are directed to an apparatus; there is no supporting structure for the steps recited. It is not clear to one of ordinary skill in the art whether the system provides for the steps or whether the claims are directed to a method. For purposes of this action only, the Examiner will interpret the claims as having supporting structure for the system to allow for the steps provided in the claims.

Claims 12 and 23 contain the trademarks/trade names JAVA, JAVASCRIPT and ACTIVEX. Where a trademark or trade name is used in a claim as a limitation to identify or

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describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe potable code and, accordingly, the identification/description is indefinite.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10, 12-29, 31 and 33-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander, US 2002/0178014 A1 (hereafter referred to as "Alexander").

Referring to claim 1. Alexander discloses a system for automatic optimization of orders of multiple items from multiple sources, which takes into account at least the item prices and the shipment prices, and generates at least one acceptable or near-optimal offer, comprising at least one server or program running on the user's computer that is capable of searching multiple vendor sites for prices and other relevant data or capable of obtaining the results from one or more such servers, and a program on the user's computer or a server fully or partially capable of executing the computations needed for finding said at least one acceptable offer (at least Abstract, Fig. 1 and ¶¶0004, 0005, 0009 and 0010 – note that Alexander discloses that is old and well-known in the art to use servers and/or programs to search multiple vendor sites for price data and Alexander discloses a program/system capable of using this data to perform the necessary computations to find at least one acceptable offer, i.e. and optimal shopping order).

Referring to claim 2. Alexander discloses further discloses the system of claim 1 wherein said at least one acceptable or near-optimal offer is defined by being within an acceptable maximum deviation from at least one lower boundary or theoretical optimum, and said lower boundary is determined by at least one of taking the lowest price available for each item and the shipment price if all of the items were available from the shop with the lowest shipment prices or other heuristic estimates (at least Fig. 1 and ¶¶0017-0019 – note the optimal shopping order is

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within the acceptable boundaries identified by the user and can be the lowest price with shipping from one vendor with all of the items).

Referring to claim 3. Alexander discloses the system of claim 2 wherein said maximum allowed deviation is determined by at least one of the system and the user and according to at least one of: the distance between the lower bound and the upper bound; automatic adjustment according to the time limit set by the user; automatic adjustment according to progress over time; statistics of similar past cases and/or statistics and/or parameters and/or characteristics of the current case; other heuristics; the user's response to the deviation recommended by the system; or if the results have been obtained after too little time the system tries again with a lower deviation (¶¶0017-0020 – note that the maximum allowed deviation is determined by the system and/or the user and according to statistics/parameters of the current case with other cases, i.e. total price must be X% or \$Y less than other vendors' prices).

Referring to claims 4-6 and 13. Alexander further discloses the system of claim 1 wherein at least one of the following features exists: said system is based on results from price comparison metasearch from multiple online vendors or shops (¶0016 – note that since the system includes the feature of using results from price comparison metasearch from multiple vendors and online shops, claims 5, 6 and 13 do not apply).

Referring to claim 7. Alexander further discloses the system of claim 1 wherein the system takes into consideration also rules for preferring and/or avoiding certain vendors which

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are at least one of: absolute, or dependant on at least one condition that relates to the order (¶0017).

Referring to claim 8. Alexander further discloses the system of claim 1 wherein after getting the at least one acceptable or near-optimal offer, the system allows the user to either make the order automatically through the meta-search site, or purchase the grouped items directly at the recommended stores, if he so prefers (¶0022).

Referring to claim 10. Alexander further discloses the system of claim 2 wherein the system provides for a user to specify the maximum deviation from said lower bound or theoretical optimum; one or more maximum search time limits (¶¶0017 and 0020 – note that the system allows the user to specify the maximum deviation from the lower bound by specifying a total price that must be met).

Referring to claim 12. Alexander discloses the system of claim 2 wherein the server can automatically choose if to make the computation itself or to transfer it to the user's computer, according to at least one of: the number of items, the number of relevant vendors, the estimated complexity, the time limit that the user agrees to, the current load on the server, and the maximum allowed deviation that the user agrees to (¶0020 – note that the optimization can be performed by the server computer itself).

Referring to claim 14. Alexander further discloses the system of claim 1 wherein the system can automatically negotiate a better deal with at least some of the suppliers and/or make reductions automatically according to pre-agreed rules with those vendors (§0018 – note that the system automatically makes reductions according to pre-agreed rules with the vendors by considering special offers by vendors).

Referring to claim 15. Alexander further discloses the system of claim 14 wherein said automatic negotiations or automatic reductions are performed at least one of: during the optimization process, or after one or more acceptable solutions have been generated (§0018).

Referring to claim 16. Alexander further discloses the system of claim 8 wherein the transfer of orders from the system's site to the individual vendors can be done by at least one of: keeping a user profile and accessing automatically a shopping cart on behalf of the user on the individual vendor's site; billing the user directly and accessing the vendor's shopping cart with the system's site's billing info; through one or more special agreed protocols for faster transferring of orders from the system's site to the vendor without having to waste time on emulating a user clicking on various options or building up a shopping cart and checking out, or giving the vendor at least one of: the user's address, the system's address, and the address of an intermediary needed for aggregation (§0022 – note that Alexander discloses it is old and well known in the art to transfer orders to the vendors by at least one of the ways suggested).

Referring to claim 17. Alexander further discloses the system claim 2 wherein if an acceptable result is not achieved within the specified time limit, then the system decides automatically or recommends to the user if to continue the attempts for additional time and/or to increase the maximum allowed deviation and try again, or to accept the result (§0020).

Referring to claim 18. Alexander further discloses the system of claim 2 wherein the system decides which heuristics to use depending on various parameters and/or statistics (§0017-0019 – note the various parameters and/or statistics are the user-defined ones and the fixed criteria).

Referring to claim 19. Alexander further discloses the system of claim 2 wherein when showing the results the system shows the user also at least one of a summary of how close a given offer is to at least one of the lower bound and the upper bound, an estimate of how close a given offer it is to the actual optimum, and the effect of the speed of shipment on the price (§0021 – note the information is shown in the optimal shopping order displayed to the user).

Referring to claim 20. Alexander further discloses the system of claim 1 wherein the user can request that the system will notify him automatically when some other condition becomes fulfilled (§0020 – note the other condition is when an optimal shopping order exists).

Referring to claim 21. Alexander discloses the system of claim 20 wherein in order to find out when the conditions have been fulfilled, the system keeps a list of such requests and of

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the users who requested them, and then the system can find out when any of these items become available at the requested prices and/or other conditions become fulfilled by at least one of the following ways: running periodically special checks for the requested items, checking for the relevant items or conditions while updating periodically the prices, or noticing the relevant items whenever they come up in metasearches conducted by any users (§0020 – note that in order to notify the user later, the system inherently keeps a list of the requests and that the system runs periodic special checks for the items).

Referring to claims 22-29, 31 and 33-42. All of the limitations in method claims 22-29, 31 and 33-42 are closely parallel to the limitations of apparatus claims 1-8, 10, and 12-21, analyzed above and are rejected on the same bases.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of Loveland, US 2001/0027404 A1 (hereafter referred to as “Loveland”).

Referring to claim 9. Alexander discloses the system of claim 1, as discussed above, wherein the system takes into consideration user preferences such as specific shops when

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computing the optimizations (§§0017-0020), but does not specifically disclose the system taking into consideration the user's indication of the acceptable distance of shops from which the user would personally pick up the item. Loveland, in the same field of endeavor and/or pertaining to the same issue, discloses a system and method for allowing users to purchase items wherein prices from several vendors may be compared and users may select vendors by geographical area so that the local vendors are the vendors selected for comparison (Fig. 4 and §0041).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Alexander to include the teachings of Lovelace to allow for the user preferences to include selection of local vendors from whom the user can pick up merchandise so that the system takes into consideration that user preference when computing the optimizations. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would allow user's to search and optimize prices based on preferences more indicative of their actual desires, thereby increasing customer satisfaction.

Referring to claim 30. All of the limitations in method claim 30 are closely parallel to the limitations of apparatus claim 9, analyzed above and are rejected on the same bases.

Claims 11 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of Official Notice.

Referring to claim 11. Alexander discloses the system of claim 1, as discussed above, wherein the user can specify preferences and modify preferences when it modifies the optimal shopping order (§§0017 and 0021), but does not explicitly disclose the system saving various

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such user preferences in its own database and/or on the user's own computer for future searches. However, it was old and well known at the time of the invention for systems to save user preferences for searches. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would save a user time in not having to repeatedly entering his preferences when repeatedly using a search engine.

Referring to claim 32. All of the limitations in method claim 32 are closely parallel to the limitations of apparatus claim 11, analyzed above and are rejected on the same bases.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chen et al., US 7,058,598 B1, discloses a method and system that enables users to search and browser for information such as price for a plurality of items, compare prices for the items individually or as a package, searches for the lowest price, and provides the user with the lowest price and location for the items (*see, e.g.*, Figs. 1-3 and cols. 2-8).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

January 26, 2007



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